

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

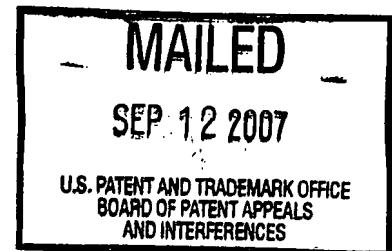
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Ex parte: DANIEL ALAN BROKENSHERE,  
BRUCE DAVID D'AMORA, GORDON CLYDE FOSSUM,  
CHARLES RAY JOHNS, JOHN SAMUEL LIBERTY  
and BRAD WILLIAM MICHAEL

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Appeal No. 2007-2038  
Application No. 09/833,348

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**REMAND TO EXAMINER**

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This application was electronically received at the Board of Patent Appeals and Interferences on August 30, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

**APPEAL BRIEF**

Appellant filed an Appeal Brief dated September 22, 2005. The Appeal Brief is not in compliance with the new rules of 37 CFR § 41.37(c) effective September 13, 2004.

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37 CFR § 41.37(c) states:

(a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

\* \* \*

(c)(1) The brief shall contain the following items...of this section:

(v) ***Summary Of Claimed Subject Matter.*** A concise statement of each ground of rejection presented for review.

An in-depth review of the Appeal Brief indicates that the following sections are missing from the Appeal Brief. The Appeal Brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus functions and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with references to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).

(ix) ***Evidence appendix.*** An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

and

37 CFR § 41.37(c)(1)(x), which is identified in the rules as:

(x) ***Related proceedings appendix.*** An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

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(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See ' 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or with any appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of the appeal.

Section 37 CFR § 41.37(c) further states:

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

An in-depth review of the Appeal Brief indicates that the following sections are defective or missing. The Summary of Claimed subject matter does not contain a concise explanation of each independent claim on appeal, it not mapped to the specification by page and line number and it does not argue all of the means plus function identified in independent Claim 18. Further the Evidence Appendix and the Related Proceeding Appendix are missing.

When the Office holds the brief to be defective due to appellant's failure to provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), an entire new brief need not, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c) will suffice. Failure to timely respond to the Office's requirement will result in dismissal of the appeal. See MPEP § 1215.04 and §711.02(b).

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### **REVISED EXAMINER'S ANSWER**

On November 14, 2006, a Revised Examiner's Answer was mailed in response to an Order Returning Undocketed Appeal mailed October 26, 2006. A review of the Revised Examiner's Answer reveals that is not in compliance with the headings as set forth in the new rules under 37 C.F.R. § 41.37(c). The following sections are defective or missing:

- 1) "Grounds of Rejection to be Reviewed on Appeal", as set forth in 37 CFR § 41.37(c)(1)(vi);

A statement of whether the Examiner agrees or disagrees with the statement o the grounds of rejection to be reviewed set forth in the brief and an explanation of any disagreements...the examiner must also include the following subheadings (if appropriate)...Grounds of Rejection Withdrawn, Grounds of Rejection Not On Review, Non-Appealable Issues and New Grounds of Rejection.

- 2) "Related Proceedings Appendix" as set forth in 37 CFR § 41.37(c)(1)(x)

Copies of any decision rendered by a court or the Board in any proceeding identified by the Examiner in the Related Appeals and Interference section of the answer.

Correction is required.

### **CONCLUSION**

Accordingly, it is

**ORDERED** that the application is returned to the examiner to:

- 1) notify appellant that the Appeal Brief filed September 22, 2005, is defective;
- 2) direct applicants to file a paper (as identified above) in compliance with 37 CFR 41.37;

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3) for the Examiner to issue and mail a form PTOL-90 a) considering and/or acknowledging Appellant's paper, b) correct the deficiencies identified above in the Examiner's Answer; and

4) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

*Patrick J. Nolan*  
PATRICK J. NOLAN  
Deputy Chief Appeals Administrator  
(571)272-9797

PJN/dpv

IBM Corp. (YA)  
C/O Yee & Associates, PC  
P.O. Box 802333  
Dallas, TX 75380